

REMARKS

Claim 11 has been modified to incorporate the limitations of claim 17.

Claim 17 has been deleted.

Claims 1-16 and 18-20 remain rejected in the application.

This application has been carefully considered in connection with the Examiner's Action. Reconsideration and allowance of the application, as amended, is respectfully requested.

Claim 11 has been amended by incorporating the limitations of claim 17. Thus, all of the limitations of claim 11, as modified, were previously incorporated into claim 17. As such, this is not an amendment which "necessitates a new grounds of rejection" because it does not introduce new issues.

Claim Rejection under 35 U.S.C. § 103

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kroening et al., U.S. Patent Number 6,080,207. Applicant respectfully traverses this rejection for at least the following reasons:

Claim 1:

Claim 1 recites:

1. A method of automatically manufacturing a computer comprising:
receiving an order from a customer;
assembling together a selection of hardware components specified by the order; and
loading onto the computer a software package specified by the order,
including:
 - providing an Internet-accessible page for the customer to specify any desired software modifications;
 - recording the modifications as an auto-configuration file; and
 - for each modification in the auto-configuration file, determining configuration data corresponding to the respective modification and entering the configuration data into the computer as the software package is being loaded.

The Office Action states that Kroening “teaches a method and corresponding apparatus for automatically manufacturing a computer comprising: receiving and order from a customer (col. 4, lines 5-45); assembling the hardware (col. 4 lines 5-45, col. 5, lines 30-35).” The Applicants respectfully assert that Kroening does not teach the claim limitation of “assembling together a selection of hardware components specified by the order.” For instance, Kroening states:

The bill of materials includes a customer’s selection of a desired software configuration for a particular computer system. Included within the bill of materials are hardware parameters of the computer system to be receiving the software configuration, including BIOS and CMOS settings plus other pertinent information as may be necessary. This information is used by the image builder to create a digital image of the desired software configuration. . . .

Information included with the bill of materials corresponds to the particular software configuration desired by a customer, plus specifics on the computer system receiving the software configuration.

Kroening, col. 4, lines 10-18 and col. 4, lines 31-33.

Kroening does not teach “receiving an order from a customer; assembling together a selection of hardware components specified by the order,” as specified in claim 1. Kroening teaches of method where the customer selects the “desired software configuration for a particular computer system.” Kroening, col. 4, lines 11-12. The hardware parameters may be used by the software configuration, but they are not customer selectable. The hardware for the computer system of Kroening has been predetermined. Nothing in Kroening indicates the customer can select the hardware, much less “assembling” of “a selection of hardware components specified by the order” as specified in claim 1.

A prima facie showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art references to make the claimed inventions. MPEP § 2143.03. The Applicant respectfully asserts that all of the limitations of the present invention are not taught by Kroening. Thus, because all of the claim limitations are not taught by the references, claim 1 is in a condition for allowance.

Claims 1-5

Additionally, the Examiner admits that Kroening does not teach “providing an Internet-accessible page for the customer to specify modifications,” “have verified modification against order details,” “logged the modifications,” and “have generated an order reference number.” The Applicants respectfully disagree that these may be obvious modifications of Kroening. In any case, however, the references (i.e., Kroening) do not teach all of the limitations of the claimed invention as required in the MPEP

§2143.03. Alternatively, if the Examiner is taking "official notice" of these limitations, then the Applicant respectfully objects to the use of official notice.

As the Examiner is aware, when a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), if the Examiner is taking official notice of the claim limitations, then Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain this reference.

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why Kroening and the Examiner's use of Official Notice cannot be applied to reject claim 1 under 35 U.S.C. §103.

Section 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed as a whole.

Without more information regarding the Examiner's references, the Applicant cannot address motivation and the desirability of the combination. Currently, the references do not teach the specific combination of elements in claim 1. Thus, it is clear that the references do not provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. Thus, the use of a §103 rejection is not proper.

Claims 2-5 depend from Claim 1 and incorporate the same limitations as Claim 1. They are, therefore, also in a condition for allowance.

Claim 6:

Claim 6 recites:

6. Apparatus for automatically manufacturing a computer, comprising:
an order unit for receiving an order from a customer;
an assembly unit for assembling together a selection of hardware components specified by the order, and
for loading onto the computer, a software package specified by the order
including:
 - an Internet-accessible page onto which the customer can specify any desired software modifications;
 - a modification unit for recording the modifications as an auto-configuration file; and
 - for each modification in the auto-configuration file, a control unit for determining configuration data corresponding to the respective modification and entering the configuration data into the computer as the software package is being loaded.

The Office Action states that Kroening “teaches a method and corresponding apparatus for automatically manufacturing a computer comprising: receiving an order from a customer (col. 4, lines 5-45); assembling the hardware (col. 4 lines 5-45, col. 5, lines 30-35).” The Applicants respectfully assert that Kroening does not teach the claim limitation of an “assembly unit for assembling together a selection of hardware components specified by the order.” For instance, Kroening states:

The bill of materials includes a customer's selection of a desired software configuration for a particular computer system. Included within the bill of materials are hardware parameters of the computer system to be receiving the software configuration, including BIOS and CMOS settings plus other pertinent information as may be necessary. This information is used by the image builder to create a digital image of the desired software configuration. . . .

Information included with the bill of materials corresponds to the particular software configuration desired by a customer, plus specifics on the computer system receiving the software configuration.

Kroening, col. 4, lines 10-18 and col. 4, lines 31-33.

Kroening does not teach “an order unit for receiving an order from a customer; an assembly unit for assembling together a selection of hardware components specified by the order,” as specified in claim 6. Kroening teaches a method where the customer selects the “desired software configuration for a particular computer system.” Kroening, col. 4, lines 11-12. The hardware for the computer system of Kroening has been predetermined. Nothing in Kroening indicates the customer can select the hardware, much less “assembling” of “a selection of hardware components specified by the order” as specified in claim 6.

A prima facie showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of

the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art references to make the claimed inventions. MPEP § 2143.03. The Applicant respectfully asserts that all of the limitations of the present invention are not taught by Kroening. Thus, because all of the claim limitations are not taught by the references, claim 6 is in a condition for allowance.

Claims 6-10:

Additionally, the Examiner admits that Kroening does not teach “providing an Internet-accessible page for the customer to specify modifications,” “have verified modification against order details,” “logged the modifications,” and “have generated an order reference number.” The Applicants disagree with the assertion that these elements are obvious modifications of Kroening. In any case, however, the references (i.e., Kroening) do not teach all of the limitations of the claimed invention as required in the MPEP §2143.03. Alternatively, if the Examiner is taking “official notice” of these limitations, then the Applicant respectfully objects to the use of official notice.

As the Examiner is aware, when a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), if the Examiner is taking official notice of the claim limitations, then Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain this reference.

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why Kroening and the Examiner’s use of Official

Notice cannot be applied to reject claim 6 under 35 U.S.C. §103.

Section 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed as a whole.

Without more information regarding the Examiner's references, the Applicant cannot address motivation and the desirability of the combination. Currently, the references do not teach the specific combination of elements in claim 6. Thus, it is clear that the references do not provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. Thus, the use of a §103 rejection is not proper.

Claims 7-10 depend from Claim 6 and incorporate the same limitations as Claim 6. They are, therefore, also in a condition for allowance.

Claim 11:

Claim 11, as modified, recites:

11. An automated computer manufacturing method comprising:
receiving an order from a customer;
downloading the order to a manufacturing unit;
including an auto-configuration indicator in the order for a special configuration requirement;
generating a flag to look for the special configuration requirement;
making an inquiry to a manufacturing database for the special configuration requirement; and if located, applying the special configuration requirement to the order, and
assembling together a selection of hardware components specified by the order,
loading into the computer a software package specified by the order, including the steps of:
providing an Internet-accessible page for the customer to specify any desired software modifications;
recording the modifications as an auto-configuration file; and for each modification in the auto-configuration file, determining any configuration data requirement corresponding to the respective modification and entering configuration requirement data into the computer as the software package is being loaded.

The Office Action states that Kroening “teaches a method and corresponding apparatus for automatically manufacturing a computer comprising: receiving an order from a customer (col. 4, lines 5-45); assembling the hardware (col. 4 lines 5-45, col. 5, lines 30-35).” The Applicants respectfully assert that Kroening does not teach the claim limitation of “assembling together a selection of hardware components specified by the order.” For instance, Kroening states:

The bill of materials includes a customer’s selection of a desired software configuration for a particular computer system. Included within the bill of materials are hardware parameters of the computer system to be receiving the software configuration, including BIOS and CMOS settings plus other pertinent information as may be necessary. This information is used by the image builder to create a digital image of the desired software configuration.

Information included with the bill of materials corresponds to the particular software configuration desired by a customer, plus specifics on the computer system receiving the software configuration.

Kroening, col. 4, lines 10-18 and col. 4, lines 31-33.

Kroening does not teach “an order unit for receiving an order from a customer; an assembly unit for assembling together a selection of hardware components specified by the order,” as specified in claim 11. Kroening teaches of method where the customer selects the “desired software configuration for a particular computer system.” Kroening, col. 4, lines 11-12. The hardware for the computer system of Kroening has been predetermined. Nothing in Kroening indicates the customer can select the hardware, much less “assembling” of “a selection of hardware components specified by the order” as specified in claim 11.

A prima facie showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art references to make the claimed inventions. MPEP § 2143.03. The Applicant respectfully asserts that all of the limitations of the present invention are not taught by Kroening. Thus, because all of the claim limitations are not taught by the references, claim 11 is in a condition for allowance.

Claims 11-16 and 18-20:

Additionally, the Examiner admits that Kroening does not teach “providing an Internet-accessible page for the customer to specify modifications,” “have verified modification against order details,” “logged the modifications,” and “have generated an order reference number.” The Applicants disagree with the assertion that these

elements are obvious modifications of Kroening. In any case, however, the references (i.e., Kroening) do not teach all of the limitations of the claimed invention as required in the MPEP §2143.03. Alternatively, if the Examiner is taking "official notice" of these limitations, then the Applicant respectfully objects to the use of official notice.

As the Examiner is aware, when a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), if the Examiner is taking official notice of the claim limitations, then Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain this reference.

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why Kroening and the Examiner's use of Official Notice cannot be applied to reject claim 11 under 35 U.S.C. §103.

Section 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed as a whole.

Without more information regarding the Examiner's references, the Applicant cannot address motivation and the desirability of the combination. Currently, the references do not teach the specific combination of elements in claim 11. Thus, it is

clear that the references do not provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. Thus, the use of a §103 rejection is not proper.

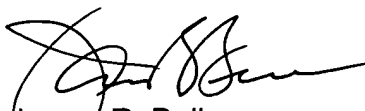
Claims 12-16 and 18-20 depend from Claim 11 and incorporate the same limitations as Claim 11. They are, therefore, also in a condition for allowance.

Conclusion

As a result of the foregoing, it is respectfully asserted that all the claims in the Application are in a condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

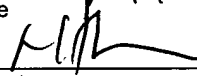
PATENT
Docket Number: 16356.486 (DC-01916)
Customer No. 000027683

Respectfully submitted,


James R. Bell
Registration No. 26,528

Dated: 3-4-03
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 512/867-8470

A-145990.1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Washington, D.C. 20231	
on	<u>3/4/03</u>
Date	<u></u>
Signature	<u>NISHI PASARYA</u>
Typed or Printed name of person signing Certificate	